

1 KEKER & VAN NEST LLP  
2 ROBERT A. VAN NEST - # 84065  
3 rvannest@kvn.com  
4 CHRISTA M. ANDERSON - # 184325  
5 canderson@kvn.com  
6 DANIEL PURCELL - # 191424  
7 dpurcell@kvn.com  
8 633 Battery Street  
9 San Francisco, CA 94111-1809  
10 Telephone: 415 391 5400  
11 Facsimile: 415 397 7188

12 KING & SPALDING LLP  
13 SCOTT T. WEINGAERTNER  
14 (*Pro Hac Vice*)  
15 sweingaertner@kslaw.com  
16 ROBERT F. PERRY  
17 rpperry@kslaw.com  
18 BRUCE W. BABER (*Pro Hac Vice*)  
19 1185 Avenue of the Americas  
20 New York, NY 10036  
21 Tel: 212.556.2100  
22 Fax: 212.556.2222

23 Attorneys for Defendant  
24 GOOGLE INC.

25 KING & SPALDING LLP  
26 DONALD F. ZIMMER, JR. - #112279  
27 fzimmer@kslaw.com  
28 CHERYL A. SABNIS - #224323  
csabnis@kslaw.com  
101 Second Street, Suite 2300  
San Francisco, CA 94105  
Tel: 415.318.1200  
Fax: 415.318.1300

IAN C. BALLON - #141819  
ballon@gtlaw.com  
HEATHER MEEKER - #172148  
meekerh@gtlaw.com  
GREENBERG TRAURIG, LLP  
1900 University Avenue  
East Palo Alto, CA 94303  
Tel: 650.328.8500  
Fax: 650.328.8508

19 UNITED STATES DISTRICT COURT  
20  
21 NORTHERN DISTRICT OF CALIFORNIA  
22  
23 SAN FRANCISCO DIVISION

24 ORACLE AMERICA, INC.,  
25 Plaintiff,  
26 v.  
27 GOOGLE INC.,  
28 Defendant.

Case No. 3:10-cv-03561 WHA

**GOOGLE INC.'S BRIEF IN OPPOSITION  
TO ORACLE MOTION TO PRECLUDE  
OWNERSHIP CHALLENGE**

Dept.: Courtroom 8, 19<sup>th</sup> Floor  
Judge: Hon. William Alsup

1 Oracle's "motion to preclude Google from disputing ownership" is an attempt by Oracle  
 2 to avoid the consequences of its failure to prove basic elements of its case, to blame Google for  
 3 that failure, and to segregate out for special treatment an issue that has already been joined in the  
 4 parties' motions for judgment as a matter of law under Rule 50. The motion is not only  
 5 procedurally improper, it is also misguided as a matter of law. Oracle confuses "ownership" of  
 6 the copyrights at issue with the legal question of *the scope of Oracle's rights*.

7 ARGUMENT AND CITATION OF AUTHORITIES

8 Oracle's theory of copyright infringement has changed multiple times during this  
 9 litigation. At different times, Oracle has characterized the works in which it claims copyrights as  
 10 "collective works," as "compilations," as "derivative works," or as free-standing works that are  
 11 part of the larger wholes that are the subject of its registrations. Oracle has also characterized its  
 12 claims based on the API packages as being claims of infringement of the "selection, arrangement  
 13 and structure" of the packages (Oracle Statement of Copyright Issues, Dkt. 899) and the  
 14 "structure, sequence and organization" of the packages (Oracle Proposed Findings and  
 15 Conclusions, Dkt. 902)—and neither of those articulations was advanced in the proposed pretrial  
 16 order. *See* Joint Proposed Pretrial Order, Dkt. 525.

17 Each of these characterizations has different consequences under the Copyright Act, and  
 18 each imposes on Oracle different burdens with respect to what it needed to prove at trial.  
 19 Selection, coordination, and arrangement are relevant to a copyright claim in a compilation, as  
 20 defined in 17 USC § 101. That section sets forth the *statutory* basis for protection. Structure,  
 21 sequence and organization, on the other hand, is a judicially created theory of infringement of  
 22 computer programs. Regardless of the theory Oracle is advancing, however, Oracle needed to  
 23 prove the contents of the complete works<sup>1</sup> that are the subject of its registrations and its

24 <sup>1</sup> Google's JMOL motion challenged the sufficiency of Oracle's proof of the work as a whole,  
 25 based on Google's assumption that Oracle was relying on TX 1076, the disc that Oracle  
 26 introduced on the last day of trial, as containing the complete work as a whole. Oracle has since  
 27 clarified that it does not rely on TX 1076, and relies instead on TX 623—which does contain, in  
 28 source code form, all of the files on which Oracle bases its claims. Google therefore does not  
 believe that there is any longer a live issue regarding whether Oracle proved the contents of the  
 version 5.0 work as a whole, and accepts that TX 623 should be treated as the work that is the  
 subject of the registrations for version 5.0.

1 ownership of any individual portions of those works on which it chose to base its infringement  
 2 allegations.

3 Under the plain language of 17 U.S.C. § 103(b), Oracle’s copyrights extend only to the  
 4 “material contributed by the author of such work, as distinguished from the preexisting material  
 5 employed in the work.” The copyrights therefore only extend to any materials included in the  
 6 works that were authored by Sun (or Sun employees).<sup>2</sup> The copyrights do not extend to any  
 7 preexisting materials created by other authors, and Oracle’s copyrights in the complete works do  
 8 not “imply any exclusive right in the preexisting material.” 17 U.S.C. § 103(b).

9 This issue of the scope of the copyrights owned by Oracle has become important because  
 10 of the unprecedented way Oracle advanced its infringement claims at trial. Oracle argued—and  
 11 the Court agreed for purposes of submitting Oracle’s claims to the jury—that small portions of  
 12 the entire works should be treated as individual “works” for purposes of its claims. Google has  
 13 objected to this approach, and has consistently argued that the “work as a whole” for infringement  
 14 purposes can and must be the entire work that is the subject of the registrations, and not a subset  
 15 or individual file contained in the larger work.

16 Oracle’s approach is contrary to both Oracle’s registrations and to the way infringement  
 17 claims are generally tried; it is as if Tolstoy argued that his copyright rights in *War & Peace* were  
 18 violated by copying a dozen sentences from the novel because those sentences were individual  
 19 works. Oracle argued, for example, that the individual files from which it claims code or  
 20 comments were copied should be considered the “work as a whole” for purposes of its claims  
 21 based on those materials. Oracle also argued that only the API packages were the appropriate  
 22 “work as a whole” for purposes of its “structure, sequence and organization” claims and its claims  
 23 based on the documentation or specifications of the API packages. This approach hopelessly  
 24 confuses ownership with infringement analysis, since “structure, sequence and organization” is  
 25 relevant, if at all, only at the infringement stage. The “structure, sequence and organization” of a

26 \_\_\_\_\_  
 27 <sup>2</sup> Under Ninth Circuit law, this includes portions of the works that were included in earlier  
 28 versions of the works. *See Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1447-48 (9th Cir. 1994).

1 work cannot be registered with the Copyright Office; the Copyright Office only registers claims  
 2 to copyright in a “work.”

3 Google has made plain multiple times that ***Google does not contest Oracle's ownership***  
 4 ***of the copyrights on which Oracle is suing.*** *E.g.*, RT 1665:3-8; RT 1884:10-13; RT 1887:6-8.  
 5 That acknowledgement, however, does not dispose of the issue of the scope of those copyrights,  
 6 nor does it relieve Oracle of the need to prove (1) ***that it has ownership rights over the individual***  
 7 ***portions of the works it singled out for purposes of trying to prove its infringement claims,*** and  
 8 (2) that Google’s copying of those portions (if proved) resulted in a material copying of the work  
 9 as registered. These two issues are very different. The first issue has become significant as a  
 10 result of the way in which Oracle has pursued its infringement claim—and has been briefed as  
 11 part of the parties’ JMOL motions under Rule 50 (as well as the parties’ proposed findings and  
 12 conclusions) and should be decided as part of those motions, to the extent necessary.

13 The only additional issues raised in Oracle’s motion are Oracle’s attempts to preclude  
 14 Google from challenging Oracle’s failure of proof. Oracle’s attempts rely on Google’s past briefs  
 15 and the pretrial order, and on a discussion with the Court regarding ownership during trial.  
 16 Neither provides a basis for excusing Oracle’s failure of proof.

17 Until Oracle put its evidence in at trial, Google did not expect that Oracle would fail to  
 18 introduce the necessary evidence to prove the extent of its rights under its registrations. Google  
 19 did not expect there to be a live issue of fact regarding Oracle’s rights, and there was no reason  
 20 for Google to propose either a jury instruction or verdict question relating to those facts or to brief  
 21 those issues prior to trial. *See* RT 2392:10-2394:19 (charge conference). These issues are issues  
 22 of law, for the Court to decide—and the parties so identified them in the pretrial order. *See* Joint  
 23 Proposed Pretrial Order, Dkt. 525 at 10 (issues of law 1 and 2). The pretrial order also identified  
 24 as potential fact issues to be addressed at trial the underlying facts relating to Oracle’s ownership  
 25 of any individual components of the works, in the event there was any dispute over what Oracle’s  
 26 proof established. *See* Dkt. 525 at 15 (issues 7-9).

27 Oracle, however, neglected entirely to prove or even attempt to prove that it owns, *e.g.*,

1 the individual files that it claims were copied or any of the individual API packages. As a result,  
 2 Oracle's copyright rights as a matter of law under 17 U.S.C. § 103(b) extend only to the works as  
 3 a whole and not any individual portions of the entire work. The pretrial order expressly identified  
 4 and preserved these issues for trial, and Google has not waived its right to pursue them based on  
 5 the lack of evidence from Oracle on these issues at trial.

6 Nor does the Court's colloquy during trial with counsel regarding ownership of the  
 7 copyright claims preclude Google's arguments. Oracle's brief makes clear that Google's counsel  
 8 said only that Google is not disputing ownership of the copyrights—which it is not. RT 713:19-  
 9 25; *see also* RT 1884:10-1887:8. Moreover, Google is not raising any ownership issue as to the  
 10 specific 37 API packages at issue, which was the concern Oracle's counsel raised at the start of  
 11 the discussion with the Court. RT 713:11-15. During the same colloquy, Google's counsel made  
 12 clear that Google was not agreeing with Oracle's argument that it had a “separate copyright on an  
 13 API package,” RT 714:13-22, and the Court observed at the conclusion of the discussion that  
 14 “this is more complicated than what you're [Oracle's counsel] proposing. . . I think there's an  
 15 issue.” RT 715:3-6.

16 Google's arguments are not barred, and have arisen as a direct result of Oracle's decision  
 17 to take scissors to its works in order to manipulate the infringement analysis with respect to the  
 18 individual files by seeking to have each of them treated as a mini-“work as a whole.” Oracle's  
 19 “motion to preclude” should be addressed as part of the parties' pending motions for judgment as  
 20 a matter of law, in connection with which these issues have been both clarified and briefed by  
 21 both parties.

22 Dated: May 8, 2012

KEKER & VAN NEST LLP

23  
 24 By: /s/ Robert A. Van Nest  
 ROBERT A. VAN NEST

25  
 26 Attorneys for Defendant  
 27 GOOGLE INC.  
 28